

REMARKS

Reconsideration and allowance of this application is respectfully requested in light of the following remarks.

Status of Claims

Claims 1-11 were pending in this application. The Rejection of claims 1-11 was appealed; the board affirmed the rejection of claims 1-8 and reversed the rejection of claims 9-11. The examiner did an additional search. Currently claims 1-8 stand rejected under 35 U.S.C. 102(b) as being anticipated by JP-10-017694, or in the alternative as being obvious from JP-10-017694 under 35 U.S.C. 103(a). Claims 9-11 stand rejected under 35 U.S.C. 102(b) as being anticipated by Zimmerman, US patent 3,679,540 or in the alternative as being obvious from Zimmerman in view of JP-10-017694. Claim 1 is amended, claims 6, 7 and 8 are cancelled. New claims 12-16 are added.

Section 102 Rejection

Claims 1-8 of the Instant Invention stand rejected under 35 U.S.C. 102(b), as being anticipated by JP-10-017694. Applicant traverses this rejection. Claim 1 is amended, claims 6-8 are cancelled. Based on the amendment to the claims, Applicants respectfully request the objections to claims 1-5, base on JP-10-017694 be withdrawn and the claims allowed.

Claims 9-11 of the Instant Invention stand rejected under 35 U.S.C. § 102(b) as being anticipated by Zimmerman, US patent 3,679,540. Applicants traverse.

To anticipate a claim, a single source must contain all of the elements of the claim. See *Hybritech Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1379, 231 USPQ 81, 90 (Fed. Cir. 1986); *Atlas Powder Co. v. E.I. du Pont De Nemours & Co.*, 750 F.2d 1569, 1574, 224 USPQ 409, 411 (Fed. Cir. 1984); *In re Marshall*, 578 F.2d 301, 304, 198 USPQ 344, 346 (C.C.P.A. 1978). Missing elements may not be supplied by the knowledge of one skilled in the art or the disclosure of another reference. See *Structural Rubber Prods. Co. v. Park Rubber Co.*, 749 F.2d 707, 716, 223 USPQ 1264, 1271 (Fed. Cir. 1984). Where a reference discloses less than all of the claimed elements, an Examiner may only rely on 35 USC § 103. See *Titanium Metals Corp. v. Banner*, 778 F.2d 775, 780, 227 USPQ 773, 777 (Fed. Cir. 1985).

In independent claim 9 the thermoplastic olefin elastomer is either ethylene-propylene rubber or ethylene-propylene-diene terpolymer rubber or combination thereof. No where in Zimmerman is ethylene-propylene rubber or ethylene-propylene-diene terpolymer rubber disclosed. The Examiner claims that in column 4, lines 54-61 teach minor amounts of other olefins, e.g. copolymers of

propylene and ethylene. However in a rejection on 35 USC § 102(b) the law is clear, the reference must therefore provide a certain degree of precision with respect to the specific compound claimed.

A compound or composition of matter is anticipated if the disclosure in a single reference places that compound or composition in possession of the public. See *In re Brown*, 329 F.2d 1006, 1011, 141 U.S.P.Q. 245, 249 (C.C.P.A. 1964). The reference must "clearly and unequivocally disclose the claimed compound or direct those skilled in the art to the compound without any need for picking, choosing, and combining various disclosures " *In re Arkley*, 455 F.2d 586, 587, 172 U.S.P.Q. 524, 526 (C.C.P.A. 1972). The reference must therefore provide a certain degree of precision with respect to the specific compound claimed.

For example, in *Ex parte Westphal*, 223 U.S.P.Q. 630 (Bd. Pat. App. 1983), the claim was directed to a composition containing 3-methylthio-4-amino-6-tert-butyl-1,2,4-triazine-5-one. The examiner rejected the claim under section 102 as anticipated by, *inter alia*, a patent to Fawzi. This patent disclosed a compound substituted at a particular position with alkyl having 1 to 8 carbon atoms, but did not specifically name the claimed tert-butyl radical. Thus, the

board found that the Fawzi patent did not provide the precision necessary for anticipation under section 102. *Id.* at 631.

Similarly, in *Arkley*, the court found that the single claimed compound was not described in the prior art within the meaning of section 102. The prior art generically disclosed a class of compounds encompassing the claimed compound, as well as over 230,000 other compounds. The board contended, however, that the prior art contained two examples that disclosed the exact precursors of the claimed compound. The court found that these examples disclosed exact precursors only to the extent that one selects the correct acid to react with a particular tertiary amine, which also must be selected. See *Arkley*, 455 F.2d at 588, 172 U.S.P.Q. at 526. The court further found that there was nothing in the reference that "'clearly and unequivocally' directs those skilled in the art to make this selection" *Id.* Thus, the court reversed the rejection under section 102.

Further *Zimmerman* teaches away from using classical elastomers such as natural and synthetic rubber, see column 4, lines 22-53. When a reference teaches away from using a material it is neither anticipated nor obvious.

With respect to claims 9-11 the objections based on 35 USC § 102(b) must be withdrawn and the claims allowed.

Amended independent claim 1 and new independent claim 12 also provide this feature and should be allowable over Zimmerman. In addition claim 1 and claim 12 disclose the feature of improved puncture strength and tensile strength respectively. Zimmerman fails to teach or suggest these features. As claim 2-5 and 11-16 depend from these claims they should be equally allowable therewith.

Section 103 Rejection

Claims 9-11 are also alternatively rejected under 35 USC § 103(a) as being obvious from Zimmerman et al. in view of Kondo JP 10-017694, and the instant specification, Applicants traverse.

The examiner is taking bits and pieces out of nonanalogous art in order to make this rejection. Claim 9 as is amended, claim 1 and new claim 12, are all drawn to a microporous sheet made by the dry stretch method. The only piece of art which teaches a microporous sheet made by a dry stretch method is Zimmerman. Now if one reads Zimmerman in column 4, lines 22-53 it states that:

The starting elastic film utilized in the preparation of the microporous films of the present invention should be differentiated from films formed from classical elastomers such as the natural and synthetic rubbers. With such

classical elastomers the stress-strain behavior, and particularly the stress-temperature relationship, is governed by entropymechanism of deformation (rubber elasticity). The positive temperature coefficient of the retractive force, i.e., decreasing stress with decreasing temperature and complete loss of elastic properties at the glass transition temperatures, are particularly consequences of entropy-elasticity. The elasticity of the starting elastic films utilized herein, on the other hand, is of a different nature.

In qualitative thermodynamic experiments with these elastic starting films, increasing stress with decreasing temperature (negative temperature coefficient) may be interpreted to mean that the elasticity of these materials is not governed by entropy effects but dependent upon an energy term. More significantly, the starting elastic films have been found to retain their stretch properties at temperatures where normal entropyeelasticity could no longer be operative. Thus, the stretch mechanism of the starting elastic films is thought to be based on energy-elasticity relationships, and these elastic films may then be referred to as "non-classical" elastomers.

As stated, the starting elastic films employed in this invention are made from a polymer of a type capable of developing a significant degree of crystallinity, as contrasted with more conventional or "classical" elastic materials such as the natural and synthetic rubbers which are substantially amorphous in their unstretched or tensionless state.

This is a clear teaching that the films made by the process of dry stretch are to be polymers capable of developing a significant degree of crystallinity and not the classical elastic materials as natural and synthetic rubber.

Motivation may be lacking when the state of the art at the time of the invention in question was discovered pointed researchers in a different direction than the inventor proceeded. Indeed, the Federal Circuit has repeatedly recognized that

proceeding contrary to the accepted wisdom in the art represents "strong evidence of unobviousness." *In re Hedges*, 783 F.2d 1038, 1041, 228 U.S.P.Q. 685, 687 (Fed. Cir. 1986); *W.L Gore & Assocs., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1552, 220 U.S.P.Q. 303, 312 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984) (prior art teaching that conventional polypropylene should have reduced crystallinity before stretching and should undergo slow stretching, led away from claimed process of producing porous article by expanding highly crystalline PTFE by rapid stretching); accord *In re Fine*, 837 F.2d 1071, 1074, 5 U.S.P.Q.2d 1596, 1599 (Fed. Cir. 1988).

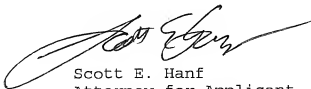
In the instant case the only reference which teaches a dry stretch process also teaches that one should use a polymer with a significant degree of crystallinity. The examiner is arguing that this could be combined with references that take about adding classical elastic materials for a solvent extraction microporous sheet (Kondo) or adding classical elastomers to non-porous sheets as referred to in the background of the invention. Zimmerman clearly teaches away from the present invention. Teaching away from the art is per se demonstration of a lack of prima facie obviousness. *In re Dow Chemical Company* 837 F. 2d 469, 5 USPQ2d 1529 (Fed. Cir. 1988).

With respect to the claim objections Applicants have provided a declaration of Ron Call to support the arguments above.

Conclusion

In view of the foregoing, the applicant respectfully requests an early Notice of Allowance in the instant application.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Scott E. Hanf', with a long, sweeping horizontal line extending to the right.

Scott E. Hanf
Attorney for Applicant
Reg. No. 38,906

Customer No. 29494
HAMMER & HANF, P.C.
3125 Springbank Lane
Suite G
Charlotte, NC 28226
Telephone: 704-927-0400
Facsimile: 704-927-0485

Attachments: Declaration (6 pages)

H:\2000\083\AmendAfter2ndAppeal\Amendment011808.doc